

IV. AMENDMENTS TO THE DRAWINGS

- THE DRAWINGS OF THE PATENT IS HEREBY AMENDED AS SET FORTH BELOW:

- *No Amendment Made to the Drawings*
- *Attachments: None*

V. REMARKS/ARGUMENTS

- STATUS OF THE CLAIMS

Claims 2 - 6 are pending in this application. Claim 1 was cancelled in the "Response to the Office Action of May 2." Claims 3 – 5 are amended herein. Claims 2 and 6 were previously presented. It is asserted that no new matter has been introduced into the disclosure due to amendment of the claims.

- OBJECTIONS

- OBJECTION UNDER 37 C.F.R. §1.75(C)

- Examiner's Stance

The Examiner has objected to claims 4 and 5 under 37 C.F.R. §1.75(c) as "being of improper dependent form for failing to further limit the subject matter of a previous claim" (section 4 of the Office Action). The Examiner asserts that the "Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form." *Id.* The Examiner notes that "[n]one of the recited compounds in claim 3 correspond to the compounds recited in claims 4 or 5, which are substituted only at the 3 position." *Id.*

- Applicants' Response

Applicants assert that the amendments to claims 4 and 5 made herein make moot the Examiner's 37 C.F.R. §1.75(c) objection. In accord with one of the Examiner's suggestions, claims 4 and 5 have been rewritten in independent form.

- REJECTIONS

- REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

- Examiner's Stance

The Examiner has rejected claims 2 – 6 under 35 U.S.C. §112, second paragraph, as being indefinite for “failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” In respect of claim 3, the Examiner asserts that “the claim should state that the recited compounds are part of the layer providing the copy protection.” (section 3 of the Office Action)

- Applicants' Response

Applicants respectfully traverses the rejection of claims 2 – 6 based in part on their assertion that one of ordinary skill in the art would find that the claims as a whole point out and distinctly claim the subject matter of the respective claims. However, in order to expedite issuance of the claims, Applicants have amended claim 3 to indicate that more or more compounds are found in a copy-protection layer associated with disc. As claims 2 and 4 – 6 depend, or previously depended, on claim 3, it is asserted that the rejection is thus obviated by the amendment to claim 3.

- REJECTION UNDER 35 U.S.C. §103 (a)

- Examiner's Stance

The Examiner has rejected claims 2 – 6 under 35 U.S.C. §103 (paragraph 6 of the Office Action) as being obvious over U.S. Patent Application Publication No. 2004/0004922 A1 in the name of Selinfreund.

The Examiner has taken the position that “[it] would have been obvious to one skilled in the art to use one of the disclosed compounds, such as those disclosed in sections [0083 - 00104] in place of those specifically used in the formation of the transient optical state changing recording medium described in section [0092] with a reasonable expectation of a useful copy protected optical recording medium” (section 6 of the Office Action). The Examiner indicates that “[b]ased upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. §102(e).” *Id.* The Examiner indicates that this rejection could be overcome by a showing under 37 C.F.R. §1.132 “that any invention

disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention 'by another'." *Id.*

- Applicants' Response

Applicants respectfully traverses the rejection of claims 2 – 6 under 35 U.S.C. §103(a) as obvious over U.S. Patent Application Publication No. 2004/0004922 A1 in the name of Selinfreund, partially on the basis that the Examiner has failed to look at the level of ordinary skill in the prior art and the differences between the claimed invention and the prior art as required under the Graham v. John Deere test (383 U.S. 1 (1966)). However, Applicant asserts that such rejection is mooted by the submission of a 1.132 affidavit, attached hereto as an exhibit, which indicates that the compounds disclosed in the claims 2 – 6, which the Examiner asserts are found in Fig. 6 (as well, as Examples 1 – 3) of U.S. Patent Application Publication No. 2004/0004922 A1, was derived by a common inventor and is thus not an invention "by another."

- REJECTION UNDER JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE PATENTING

- Examiner's Stance

The Examiner has rejected claims 2 – 6 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 17 of co-pending Application No. 10/418898 (U.S. Patent Application Publication 2004/004922). The Examiner assert "[a]though the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the co-pending application clearly embrace copy protected optical recording media using the claimed phenothiazines as these are fully encompassed by the claims of the co-pending application as evidenced by sections [0083-0104] of the co-pending application" (section 8 of the Office Action). The Examiner asserts:[t]his is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented." *Id.*

- Applicants' Response

Applicants respectfully traverses the rejection under the judicially created doctrine of obviousness-type double patenting on the basis that the claims are distinct and

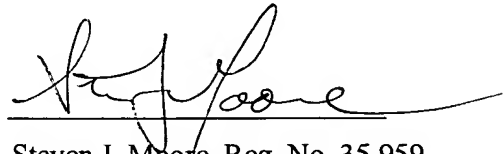
have not issued. However, Applicants agree to submit a terminal disclaimer should the claims in co-pending Application No. 10/418898 issue and the claims herein found to be allowable.

CONCLUSION TO REMARKS

Applicants assert that this response is fully responsive to the Examiner's office action dated August 14, 2006. Applicants respectfully seek early allowance of the pending claims.

Date: January 16, 2007

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "S. J. Moore", is written over a horizontal line.

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VI. APPENDIX

- *1.132 Affidavit attached*

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants:	Selinfreund, Gerger, Vig and Li	Art Unit:	1756
Serial No.:	10/672,052	Confirmation No.	7180
Filing Date:	September 26, 2003	Examiner:	Angebranndt, Martin J.
Title:	Transient Optical State Change Materials Useful in Copy-protected Compact Discs	Docket No.:	VTI-114.4B(US)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. § 1.132

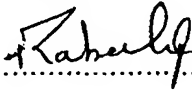
Dear Sir:

I, Rakesh Vig, declare as follows:

1. I am a co-inventor of the above identified patent application.
2. I am a co-inventor of U.S. Patent Application Publication No. 2004/0004922 A1, entitled "Materials for Optical Medium Copy-Protection Transiently Reacting to a Reader Beam," naming Selinfreund, Gerger, Goyette, Colandreo, Vig, Li, Cook and Turner as inventors.
3. I declare that any invention disclosed at Fig. 6, but not claimed, and examples 1 - 3, of U.S. Patent Application Publication No. 2004/0004922 A1, was derived from me and is thus not an invention "by another."
4. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the

United States Code, and that such willful false statements may jeopardize the validity of the above-referenced application or any patent issuing thereon.

Date: 01/15/07.....

Signed: .....

Rakesh Vig